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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,861	08/04/2000	Masayuki Chatani	375.05.01	2447
25920	7590	11/02/2005	EXAMINER	
MARTINE PENILLA & GENCARELLA, LLP			ABDI, KAMBIZ	
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SUITE 200			PAPER NUMBER	
SUNNYVALE, CA 94085			3621	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,861

Applicant(s)

CHATANI, MASAYUKI

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 9, 17, 19, and 20 are amended.
- Claims 1-12 and 17-24 have been considered.

Response to Arguments

2. Applicant's arguments, see applicant's arguments, filed 12 July 2004 and 15 August 2005 with respect to the rejection(s) of claim(s) 1, 9, 17, and 22 under 35 U.S.C. 112, 2nd paragraph, have been fully considered and are persuasive. Therefore, the rejection under 35 U.S.C. 112, 2nd paragraph has been withdrawn. However, upon further consideration, the ground(s) of rejection is made under 35 U.S.C. 103(a) is maintained and refined for further clarify the offices position.

Claim Rejections - 35 USC § 103

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo, in view of U.S. Patent No. 5,063,547 to Pieter H. Custer.

4. As per claims 1 and 9, Russo, Garfinkle and Peterson disclose a method and system for providing access to primary media content in digital form, comprising:

- a server network comprising a download management server, a customer database storing user information, and a primary content database storing primary media content (See Russo figures 1, 2 and associated text, column 3, lines 1-28, and column 4, lines 22-68);
- a client console connectable for establishing a communications link through a bi-directional communications network to said download management server (See Russo figures 1, 2 and associated text, column 3, lines 1-28, column 4, lines 22-68, and column 5, lines 1-65);
- the client console storing user specific information (See Russo column 6, lines 8-63);

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- a detachable storage media installable in said client console (See Russo column 7, lines 34-61);
- said detachable storage media having a media identifier (See Russo column 7, lines 34-61),
- the user identifier is uploaded to said download management server to enable access to specified content in said primary media content database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- said specified content and said user information is downloaded to said client console (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the specified content being associated with billing trigger data to enable monitoring of when specific portions of the specified content is accessed for use at said client console (See Russo column 3, lines 1-28, column 5, lines 1-64, column 10, lines 11-68, and column 11, lines 1-15),
- the monitoring being configured to generate a record of used content (See Russo column 10, lines 10-68),
- the record of used content being communicated back to the management server to record a revenue bearing event in the customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- Charging only for portion of the specific content used at the client console (See Russo figure 2 and associated text, and column 5, lines 1-9, column 5, lines 33-65, column 9, lines 38-65, and column 10, lines 10-48),
- wherein the media identifier is combined with the user specific information to define a user identifier (See Custer abstract, figures 2 and 3 and associated text, column 2, lines 3-34, column 4, lines 3-23, and column 6, lines 34-63),

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5. Though, Russo is not explicit about the specifics of the identification data transmitted between the client console and the central server. However, Custer is clear on how to achieve a better relations among preferred selection of content by the users and making the identification of the data associated with both specific end user and the users chosen specific content by combining the user specific information and specific content information to create a unique ID (See Custer column 2, lines 3-35, column 4, lines 3-52, column 5, lines 25-29, and column 6, lines 34-52). In addition this method of creating specific identifiers based on combining a user specific information with the specific medium identifier such as serial number or content identifiers such as the content number to arrive at an specific identifier, which would tie the user with the content is well known in the art as shown by Peterson (See U.S Patent no. 5,857,020 to Mendel Lazear Peterson, Abstract, figures 1-3 and associated text, Column 2, lines 18-68, column 3, lines 1-46, column 5, lines 15-25, column 6, lines 8-41, column 8, lines 5-51). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Russo and Custer to achieve the uniqueness of the ID (identification data) that is needed for distribution of specific content to a specific end user (Motivation can be found in Russo column 8, lines 19-40).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of primary reference Russo with that of Custer to achieve the uniqueness of the ID (identification data) that is needed for distribution of specific content to an end user (Motivation can be found in Russo column 8, lines 19-40).

6. As per claim 2, Russo and Custer disclose all the limitations of claim 1, further;

Russo discloses,

wherein said user identifier comprises an alphanumeric media ID identifying said detachable storage media said alphanumeric media ID defining a level of access available when accessing the primary media content database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

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7. As per claim 3, Russo and Custer disclose all the limitations of claim 2, further;

Russo discloses,

wherein said specified content comprises a portion of an overall set of primary contents stored in said contents database, and wherein said media ID serves to limit access to particular ones of the overall set of primary contents of the specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

8. As per claim 4, Russo and Custer disclose all the limitations of claim 1, further;

Russo discloses,

wherein said specified content is associated with an authentication code for authenticating access to the download management server (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

9. As per claim 5, Russo and Custer disclose all the limitations of claim 4, further;

Russo discloses,

wherein said specified content comprises a portion of an overall set of primary contents stored in said contents database, and wherein said authentication code authenticates access to the download management server which is responsible for providing access to said specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

10. As per claim 6, Russo and Custer disclose all the limitations of claim 1, further;

Russo discloses,

wherein each portion of the specified content is associated with respective billing trigger data, the billing trigger data tracks usage to generate a usage history of the primary media

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content in the customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

11. As per claim 7, Russo and Custer disclose all the limitations of claim 6, further;

Russo discloses,

wherein said detachable storage media includes a program for providing network access and code which causes execution of a program stored in said media console for providing network access (See Russo column 7, lines 34-61, and column 9, lines 11-68).

12. As per claim 8, Russo and Custer disclose all the limitations of claim 1, further;

Russo discloses,

wherein said client console further comprises a local fixed storage device disposed internally or externally of said client console, wherein said specified content is downloaded only to said fixed storage device (See Russo figure 2 and associated text, column 4, lines 45-65, column 5, lines 33-65, column 6, lines 12-53, column 8, lines 11-19, and column 10, lines 54-59).

13. As per claim 10, Russo and Custer disclose all the limitations of claim 9, further;

Russo discloses,

wherein said media ID identifies said detachable storage media, further comprising the step of receiving said media ID and an authentication code from said client console at said download management server, wherein one of said authentication code and said media ID server to limit access to particular portion of said primary media content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

14. As per claim 11, Russo and Custer disclose all the limitations of claim 9, further;

Russo discloses,

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wherein the billing trigger data assists in compiling usage information of the specified content in a customer database (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

15. As per claim 12, Russo and Custer disclose all the limitations of claim 9, further;
Russo discloses,

wherein said step of downloading to said client console from said download management server comprises storing said specified content on a local fixed storage device disposed internally or externally of said client console (See Russo figure 2 and associated text, column 4, lines 45-65, column 5, lines 33-65, column 6, lines 12-53, column 8, lines 11-19, and column 10, lines 54-59).

16. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

17. Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,619,247 to James Russo in view of U.S. Patent No. 5,063,547 to Pieter H. Custer.

18. As per claim 17 and 20, Russo discloses a method and computer readable media having program instructions for obtaining media content at a client computer, comprising:

- communicating a request from the client computer to a content provider for specified content
(See Russo figures 1, 2 and associated text, column 3, lines 1-28, and column 4, lines 22-68),

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- the request including a media ID of a detachable media and user information (See Russo column 6, lines 8-63 and column 7, lines 34-61),
- downloading the specified content to the client computer (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the specified content being associated with billing triggering data (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the billing triggering data being configured to assist in tracking when portions of the specified content is used at the client computer (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38); and
- returning information regarding the tracked usage of the portions of the specified content to the content provider (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38),
- the media ID and the user information defining a user identifier (See Custer abstract, figures 2 and 3 and associated text, column 2, lines 3-34, column 4, lines 3-23, and column 6, lines 34-63),

19. Though, Russo is not explicit about the specifics of the identification data transmitted between the client console and the central server. However, Custer is clear on how to achieve a better relations among preferred selection of content by the users and making the identification of the data associated with both specific end user and the users chosen specific content by combining the user specific information and specific content information to create a unique ID (See Custer column 2, lines 3-35, column 4, lines 3-52, column 5, lines 25-29, and column 6, lines 34-52). In addition this method of creating specific identifiers based on combining a user specific information with the specific medium identifier such as serial number or content identifiers such as the content number to arrive at an specific identifier, which would tie the user with the content is well known in the art as shown by Peterson (See U.S Patent no. 5,857,020 to Mendel Lazear Peterson, Abstract, figures 1-3 and associated text, Column 2, lines 18-68, column 3, lines 1-46, column 5, lines 15-25, column 6, lines 8-41,

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column 8, lines 5-51). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Russo and Custer to achieve the uniqueness of the ID (identification data) that is needed for distribution of specific content to a specific end user (Motivation can be found in Russo column 8, lines 19-40).

20. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of primary reference Russo with that of Custer to achieve the uniqueness of the ID (identification data) that is needed for distribution of specific content to an end user (Motivation can be found in Russo column 8, lines 19-40).

21. As per claim 18 and 21, Russo, and Custer disclose all the limitations of claim 17 and 20, further;

Russo discloses,

wherein the tracked usage is associated with the user information to enable billing for the usage of the portions of the specified content (See Russo figure 2 and associated text, and column 5, lines 52-65, column 6, lines 12-33, and column 10, lines 10-38).

22. As per claims 19 and 22, Russo, Peterson and Custer disclose all the limitations of claims 17 and 20, further;

Russo discloses,

wherein the specified content is downloaded the client computer, but billing for the downloaded specified content is not triggered until usage of at least a portion of the specified content at the client computer (See Russo figure 2 and associated text, and column 3, lines 1-28, column 5, lines 1-65, column 6, lines 12-33, and column 10, lines 10-38).

23. As per claim 23, Russo, Peterson and Custer disclose all the limitations of claims 17 and 20, further;

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Russo discloses,

wherein the computer readable media is packaged media (See Russo column 7, lines 34-61).

24. As per claim 24, Russo, Peterson and Custer disclose all the limitations of claims 17 and 20, further;

Russo discloses,

wherein the packaged media is a compact disc (See Russo column 7, lines 34-61).

25. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Patent No. 5809145, to David Slik et al., System for Distributing Digital Information.
- Patent No. 6308204, to Guy Nathan et al., Method of Communications for An Intelligent Digital Audiovisual Playback System.
- Patent No. 5530754, Norton Garfinkle, Video On Deman..
- Patent No. 5857020, to Mendel Lazear Peterson, Timed Availability of Secured Content Provisioned on A Storage Medium.

27. All the above patents are directly related to the claimed invention and teach the similar methods and systems. However, they have not been used in the body of the rejection for simplifying the office action and prevention of confusion that apparently was present in the pervious office actions.

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28. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to **Kambiz Abdi** whose telephone number is **(571) 272-6702**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

<http://portal.uspto.gov/external/portal/pair>

30. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6702 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the

Knox Building, 50 Dulany St. Alexandria, VA.

Kambiz Abdi
Examiner



October 27, 2005